UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: July 30, 2005

Opposition No. 91160810

SmithKline Beecham Corporation

v.

Therox, Inc.

Cheryl Butler, Attorney, Trademark Trial and Appeal Board:

In accordance with the Board's institution order of June 9, 2004, discovery closed on December 26, 2004. This case now comes up on applicant's motion, filed by certificate of mailing dated February 11, 2005, to reopen the discovery period, reset all dates, and to compel opposer's responses to applicant's discovery requests, served January 7, 2005. Opposer filed a response to applicant's motion.

In support of its motion, applicant explains that there are two oppositions involving two different opposers pending against its application Serial No. 78116976; and that each opposition was filed in June 2004 but on different days. Applicant indicates that it has timely filed answers in both proceedings. Applicant argues that it served discovery requests in this case on January 7, 2005, believing that such requests were timely until informed by opposer that opposer would not respond to the requests because they were untimely. Upon investigation, applicant argues that it realized the close of discovery for this case was docketed for

January 9, 2005, the same day as the close of discovery for the other opposition pending against its application. Applicant argues that a number of other circumstances contributed to the inadvertent docketing error not being uncovered. According to applicant, its attorney was participating in preparation for a jury trial in a different case that required her to be absent from the office most of the fall of 2004; during the same time, the established secretary for applicant's attorney left employment with the firm and an temporary secretary, unfamiliar with Board proceedings, was assigned; and that, early in January 2005, applicant's attorney suffered an accident requiring hospitalization and emergency reconstructive surgery. Applicant requests that discovery be reopened and that opposer be required to respond to applicant's discovery requests.

In response, opposer argues that applicant has not shown excusable neglect so as to warrant a reopening of the discovery period. Opposer argues that applicant's docketing error was within applicant's control, and the other circumstances described by applicant are irrelevant to the docketing error. In addition, opposer contends that applicant's motion to compel is improper because applicant's discovery requests were untimely.

Pursuant to Fed. R. Civ. P. 6(b)(2), the requisite showing for reopening an expired period is that of excusable neglect. In *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership,* 507 U.S. 380, 395 (1993), the Supreme Court endorsed four factors to be considered in taking into account all

the relevant circumstances in determining excusable neglect. Those factors are: (1) the danger of prejudice to the non-moving party; (2) the length of delay and its potential impact on judicial proceedings; (3) the reason for the delay, including whether it was within the reasonable control of the moving party; and, (4) whether the moving party has acted in good faith. In subsequent applications of this test by the Circuit Courts of Appeal, several courts have stated that the third factor must be considered the most important factor in a particular case. *See Pumpkin Ltd. v. The Seed Corps,* 43 USPQ2d 1582, 1586 at fn.7 (TTAB 1997). Nonetheless, "although inadvertence, ignorance of the rules, or mistakes construing the rules do not usually constitute "excusable" neglect, it is clear that "excusable neglect" under Rule 6(b)[1] is a somewhat "elastic concept" and is not limited strictly to omissions caused by circumstances beyond the control of the movant." *Pioneer,* 507 U.S. at 392.

The Board first looks at factors (1), (2) and (4). There is no showing on this record that danger of prejudice to the opposer exists. Applicant acted quickly upon realizing that its discovery responses were untimely, by first contacting opposer for its consent to reopen and then by bringing its motion to reopen. Thus, the length of the delay and the potential impact on this proceeding are adjudged to be minimal. There is no

[1] The reference is to Fed. R. Civ. P. 6(b).

evidence that applicant has acted in bad faith.[2] Thus, these factors are neutral or weigh in applicant's favor.

With respect to the third factor, mere docketing errors and breakdowns are insufficient to establish excusable neglect. *See Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg., Co.,* 55USPQ2d 1848 (TTAB 2002); and *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997). In *Pumpkin*, opposer's attorney did not know why the case was not properly called up for plaintiff's testimony period; and the Board observed the significance of the dates missed being those selected by plaintiff in its previously granted motion to extend trial dates. In *Baron Philippe*, the Board found that defendant's overall pattern of delay caused extreme prejudice to plaintiff; that defendant had filed an excessive number of motions to enlarge its time to act, rather than moving forward on the case; and that the assertion of defendant's attorney, an experienced practitioner before the Board, that he read the wrong Trademark Rule before providing docketing instructions to his secretary was not credible.

Here, in accordance with precedent, the docketing error alone does not constitute excusable neglect. However, confusion arising from the second opposition concerning the same application, and lack of experience of the temporarily assigned secretary contributed to the original docketing error and the delinquent discovery of such error. There is no evidence of any

[2] The Board notes in passing that applicant responded to opposer's discovery requests, thus actively participating in the case.

other dilatory or improper conduct by applicant; and there is no evidence that applicant undertook an activity that put it on greater notice of the error (*i.e.*, proposed the dates to be relied upon, as in *Pumpkin,* or read the wrong rule which could not have led to the conclusion asserted, as in *Baron Philippe*). Thus, after considering all four *Pioneer* factors, the Board finds that applicant has established excusable neglect so as to warrant a reopening of the discovery period.

Accordingly, applicant's motion to reopen discovery is granted. *See* Fed. R. Civ. P. 6(b)(2).

Applicant's motion to compel responses to its discovery requests, served out of time, is denied inasmuch as the motion is untimely.

In order to expedite matters, applicant's discovery requests (originally served January 7, 2005) are considered effectively re-served as of the mailing date of this order. Opposer is allowed until **thirty-five days** from the mailing date of this order in which to serve its responses. (This is simply a scheduling order, not an order compelling discovery.)

Discovery and trial dates are reset as indicated below:

THE PERIOD FOR DISCOVERY TO CLOSE:	October 1, 2005
30-day testimony period for party in position of plaintiff to close:	December 30, 2005
30-day testimony period for party in position of defendant to close:	February 28, 2006
15-day rebuttal testimony period to close:	April 14, 2006

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Rule 2.l25.

Briefs shall be filed in accordance with Rule 2.l28(a) and (b). An oral hearing will be set only upon request filed as provided by Rule 2.l29.

☼☼☼